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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,179	02/16/2001	Veronique Chevalier	202443US0	3089

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[REDACTED] EXAMINER

WILLIS, MICHAEL A

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1619

DATE MAILED: 12/18/2001

✓

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/784,179	CHEVALIER ET AL
	Examiner	Art Unit
	Michael A. Willis	1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 June 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-22 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

4) Interview Summary (PTO-413) Paper No(s). _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claims 1-22 are pending.

Specification

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper (see pages 6 and 18 of the specification). Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1, 4-7, 9, 10, 12, 15-18, 20, and 21 are rejected due to the phrase "derivative thereof". While a number of derivatives of hydroquinone are listed on pages 5-8 of the specification, it is unclear if this list is comprehensive, or whether the phrase

includes other compounds that are not disclosed or exemplified. The specification does not provide a standard for ascertaining whether a particular compound is a hydroquinone derivative or not. Therefore, the metes and bounds of the phrase are unclear.

4. Any remaining claims are rejected for depending from an indefinite base claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 8, 12-14, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Philippe et al (WO 99/10318). Philippe discloses aminophenol derivatives and methods for depigmenting skin or hair (see abstract). A preferred derivative is N-cholesteryloxycarbonyl-4-aminophenol (see page 4, lines 35-40). Compositions comprising 0.001-10% by weight of the derivative are disclosed (see page 6, lines 1-3). Lipid vesicles are also disclosed (see page 6, lines 5-11). Philippe discloses that the aminophenol derivatives can also be combined with other depigmenting agents, including hydroquinone (see page 7, lines 12-21).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philippe et al (WO 99/10318).

10. Philippe teaches the use of aminophenol derivatives in cosmetics for depigmenting and/or bleaching skin or hair (see abstract). A preferred derivative is N-cholesteryloxycarbonyl-4-aminophenol (see page 4, lines 35-40; and example 3, page 8, lines 17-29). Compositions comprising 0.001-10% by weight of the derivative are taught (see page 6, lines 1-3). Lipid vesicles are also taught (see page 6, lines 5-11 and 27-29). The reference teaches that the aminophenol derivatives, when combined with other depigmenting agents such as hydroquinone, allow the hydroquinone to be used at doses that are less toxic to the skin and that when the components are incompatible

they can be incorporated in vesicles (see page 7, lines 11-21). The reference lacks the weight percentages of the hydroquinone.

11. While the reference is silent regarding % by weight of hydroquinone, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions taught by Philippe by the routine optimization of the concentration of hydroquinone in order to benefit from compositions that are less toxic to the skin as taught by Philippe.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tuloup et al (US Pat. 6,159,482) discloses compositions comprising 4-aminophenol derivatives for depigmenting skin or hair. The compositions can include hydroquinone. Chevalier et al (EP 0 962 224, see US Pat. 6,203,781 for English language equivalent) discloses the use of hydroquinone or N-cholesteryloxycarbonyl-4-aminophenol in combination with optical brighteners for depigmenting the skin.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L. Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-2742 for regular communications and (703) 308-2742 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Michael A. Willis
Michael A. Willis
Examiner
Art Unit 1619

December 13, 2001

michael g. hartley
MICHAEL G. HARTLEY
PRIMARY EXAMINER